

Application No.: 10/586,299

REMARKS

These amendment and remarks are filed in response to the final Office Action mailed February 13, 2009. For the following reasons, this application should be allowed and the application passed to issue. No new matter is introduced by this amendment. The amendment to claim 5 and new claims 7 and 8 are supported by Fig. 1A and the accompanying portions of the specification.

Claims 1-8 are pending in this application. Claims 1-4 were withdrawn pursuant to a restriction requirement. Claims 5 and 6 are rejected. Claim 5 is amended in this response. Claims 7 and 8 are newly added in this response.

Claim Rejections Under 35 U.S.C. § 103

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohki (US 2003/0123769). The Examiner noted that the claimed heat treating temperatures and steel composition overlapped those disclosed in Ohki. The Examiner asserted that the steel of Ohki would have the same hardness as claimed because it has the same composition and same carbonitriding process. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Ohki does not teach or suggest the claimed heat treatment method for steel because Ohki does not teach or suggest tempering the part a second time after quenching a second time, as required by claim 5. Ohki does not teach or suggest two tempering steps, as required by claim 5. It would not have been obvious to one of ordinary skill in this art to include an additional tempering step in the Ohki process as the additional tempering step would increase the cost and time required to make the part.

The present method is further distinguishable over Ohki because Ohki does not suggest the unexpectedly improved properties of parts processed according to the claimed method, such

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as the lower rate of dimensional change (Table 4) of parts formed according to the claimed method.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 22006); *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Ohki to modify the method of Ohki to include two tempering steps, as required by claim 5, nor does common sense dictate the Office-asserted modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 500 U.S. ____ (No. 04-1350, April 30, 2007) at 20.

The only teaching of the claimed heat treatment method is found in Applicant's disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The dependent claims, including new claims 7 and 8, are allowable for at least the same reasons as claim 5, and further distinguish the claimed heat treatment method.

In view of the above remarks, Applicant submits that this application should be allowed and the case passed to issue. If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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